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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

WU, RUTAO

ART UNIT PAPER NUMBER

3639

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/942,912	<b>Applicant(s)</b> SUZUKI, JUN	
	<b>Examiner</b> Rutao Wu	<b>Art Unit</b> 3639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

*C/C*

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: S401. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claims 1-3 only recite an abstract idea. The recited steps of retrieving selling price of a desired product and steps of negotiating the sell price of said desired product does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and

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paper. These steps only constitute an idea of how to determine the sell price of a desired item.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a

mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

- (c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention retrieves pricing information and allows for negotiation (i.e., repeatable) used in determining the best selling price of a desired product (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-3 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 5, 7, 8, 10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,064,981 to Barni et al.

**Referring to claims 1, 4, 7:**

A price information mediating process for providing selling price information of at least one product supplier to at least one user: said process comprising the steps of:

- a) receiving product search conditions from said user; (col 5: lines 36-50)
- b) retrieving a normal selling price of a desired product from storage means in accordance with said product search condition from said user, said storage means including normal selling price information which have been pre-registered by said product supplier; (col 2: lines 2-4; col 5: lines 19-21)
- c) sending said retrieved normal selling price to said user; (col 6: lines 3-6)
- d) receiving a desired purchasing price presented by said user; and (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)
- e) sending said desired purchasing price to said product supplier. (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)

**Referring to claims 2 and 5:**

A price information mediating process for providing selling price information of at least one product supplier to at least one user: said process comprising the steps of:

- a) receiving product search conditions from said user; (col 5: lines 36-50)

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b) retrieving a normal selling price of a desired product from storage means in accordance with said product search condition from said user, said storage means including normal selling price information and allowable discount selling price corresponding to said normal selling price which have been pre-registered by said product supplier; (col 2: lines 2-4; col 5: lines 19-21)

c) sending said retrieved normal selling price to said user; (col 6: lines 3-6)

d) receiving a desired purchasing price presented by said user; and (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)

e) sending said desired purchasing price to said product supplier if said desired purchase price is greater than said allowable discount selling price. (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)

**Referring to claim 8:**

The server as claimed in Claim 7, wherein said storage means also stores allowable discount selling price corresponding to said normal selling price which have been pre-registered by said product supplier, said second sending means determines whether said desired purchasing price is greater than said allowable discount selling price and sends said desired purchasing price to said product supplier when said second sending means determines that said desired purchasing price is greater than said allowable discount selling price. (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)

**Referring to claim 10:**

The server as claimed in claim 7, further comprising:



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Fourth receiving means for receiving selling permission reporting information from the shop terminal; and (col 6: lines 13-18)

Third sending means for sending said selling permission reporting information to said user terminal. (col 6: lines 1-6)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barni et al in view of U.S. Pub No 2002/0010611 to Yamaji et al.

As per claims 3 and 6, Barni discloses the following limitations:

Receiving product search conditions from said user; (col 5: lines 36-50)

Retrieving a normal selling price of a desired product from first storage means in accordance with said product search condition from said user, said first storage means including normal selling price information which have been pre-registered by said product supplier; (col 2: lines 2-4; col 5: lines 19-21)

Sending said retrieved normal selling price to said user; (col 6: lines 3-6)

Receiving a desired purchasing price presented by said user; (col 2: lines 14-17; col 5: lines 31-35; col 6: lines 22-25)

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Storing said desired purchasing price in second storage means; (col 8: lines 14-18)

Receiving a request for updating said normal selling price stored in said first storage means; and (Fig 3)

Barni does not disclose the system notifying users in case normal selling price takes a value less than the desired purchase price after a seller update.

Yamaji discloses in his application that the customers can choose notification options. For example, automatic notification when discount rate changes by a predetermined value or more, notification in the case where a more advantageous condition occurs on another date of delivery, etc. [0074] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barni's invention to include a notification option. One would be motivated to perform such modification to assist the users in obtaining the best price for a desired product.

As per claim 9, Barni discloses means for receiving a request for updating normal selling price. (Fig 3)

Barni does not disclose the system notifying users in case normal selling price takes a value less than the desired purchase price after a seller update.

Yamaji discloses in his application that the customers can choose notification options. For example, automatic notification when discount rate changes by a predetermined value or more, notification in the case where a more advantageous condition occurs on another date of delivery, etc. [0074] Therefore, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to modify Barni's invention to include a notification option. One would be motivated to perform such modification to assist the users in obtaining the best price for a desired product.

### ***Conclusion***

1. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat No. 5,615,269 to Micali.

U.S. Pat No. 5,666,493 to Wojcik et al.

U.S. Pat No. 5,933,813 to Teicher et al.

U.S. Pat No. 6,141,653 to Conklin et al.

U.S. Pat No. 6,236,972 to Shkedy et al.

U.S. Pat No. 6,249,772 to Walker et al.

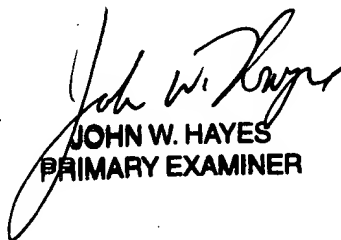
U.S. Pat No. 6,553,347 to Tavor et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw

  
JOHN W. HAYES  
PRIMARY EXAMINER